

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) S63.2-14157-US01			
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>September 29, 2008</u></p> <p>Signature <u>/James M. Urzedowski/</u></p> <p>Typed or printed name <u>James M. Urzedowski</u></p>	Application Number 10/645653	Filed 8/20/2003			
	First Named Inventor Freyman et al.				
	Art Unit 3736	Examiner Catherine Witczak			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>48596</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><p><u>/James M. Urzedowski/</u> Signature <u>James M. Urzedowski</u> Typed or printed name <u>952-563-3000</u> Telephone number <u>September 29, 2008</u> Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>48596</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p><u>/James M. Urzedowski/</u> Signature <u>James M. Urzedowski</u> Typed or printed name <u>952-563-3000</u> Telephone number <u>September 29, 2008</u> Date</p>
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<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>					

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REASONS FOR PRE-APPEAL CONFERENCE

This paper is being filed in response to the Advisory Action dated August 20, 2008 and the Final Office Action dated May 28, 2008. The rejection of claims 25-40 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,713,853 to Clark et al. ("Clark") in view of U S Patent No. 6,364,856 to Ding et al. ("Ding") has been maintained.

Independent claim 25 of the present application is directed to a medical device having among other features a self-expanding delivery member “shaped in a continuous solid cylindrical configuration”.

In rejecting the instant claim and those dependent therefrom, the Examiner cited Clark as disclosing all of the features of the instant claim, except for a delivery member being shaped in a continuously solid cylindrical configuration. The Examiner stated that it would be obvious to modify the device of Clark with a continuously solid delivery member (asserted by the Examiner to be disclosed by Ding) “since such a structure would ensure maximum contact with the treatment area when the delivery member is in its expanded state.”

Applicants disagree with this rejection and the basis upon which the Examiner has relied on making it.

In the Clark reference the delivery member is in fact a plurality of delivery members 502 or with spaced ribs 702. The members or ribs of Clark are intended to allow the device to serve as a thrombolytic filter. The ribs can be solid or can define a series of ports or lumens (column 12, lines 61-65), but in any case they are configured to

allow blood to flow to tissue distal to the delivery site through the regions defined by the ribs (column 14, lines 38-40). If the device is modified to contain a delivery member with a continuous solid cylindrical configuration without gaps between ribs, it would no longer allow for blood to reach tissue distal the delivery site and would no longer perform act as a filter.

Thus, based on the above, while Clark certainly teaches away from any modification that would require the delivery member to be configured in the manner recited in the instant claims, it is also apparent that a modification forcing Clark to incorporate a delivery member having a continuous solid cylindrical configuration would interfere with the stated function of the Clark device. Simply put, one of ordinary skill in the art would not seek to structurally modify the filter of Clark in such a way that it is no longer capable of acting as a filter.

As stated in the Manual of Patent Examiner Procedure, "It is improper to combine references where the references teach away from their combination." MPEP, 8th Ed. Rev. 6 (Sep. 2007) § 2145(X)(D)(2); *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1740 (2007); *Takeda Chem. Indus., Ltd. v Alphapharm Pty. Ltd.*, 492 F.3d 1350, 1358-59 (Fed. Cir. 2007) (finding the prior art taught away from the claims and the claims therefore were not invalid). Clark clearly shows and describes multiple delivery members or ribs (see elements 502 and 706 for examples) which collectively act as a filter to allow blood to flow therethrough while catching or removing a thrombus or plaque (column 12, lines 61-65 & column 14, lines 39-43). The filter described in Clark is clearly distinct from the continuous solid cylindrical member of the present application in both structure and function; regardless of the teaching of Ding, one of ordinary skill

would not be motivated to modify such a filter in a manner that would render the filter incapable of functioning as such.

To that end, it must also be noted that MPEP § 2143.01 states "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." In the present case there is no doubt that the Examiner's proposed modification of Clark would render the described filter unsatisfactory for its intended purpose.

In light of the above, Applicants assert that it would not be obvious to one having ordinary skill in the art to modify the device of Clark to contain a delivery member with a continuous solid cylindrical configuration such as instant claims 25 describes. Therefore, Applicants respectfully request that the rejection of independent claim 25 be reversed. Applicants respectfully request that the rejection of dependent claims 26-40 likewise be reversed for at least the same reasons that the rejection of independent claim 25 should be reversed.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: September 29, 2008

By: /James M. Urzedowski/
James M. Urzedowski
Registration No.: 48596